

REMARKS

Claims 84-122 are pending in this application. By this Amendment, claims 84-122 are added and claims 1-12, 14-20 and 22-83 are canceled without prejudice to, or disclaimer of, the subject matter recited in those claims. No new matter is added. Reconsideration of the application based on the above amendments and the following remarks is respectfully requested.

I. Recent Prosecution History

The Office Action to which this Amendment responds was mailed on February 23, 2006. Applicant timely filed a Notice of Appeal and Petition for Extension of Time on August 23, 2006. A Request for Continued Examination is attached.

II. Claims Recite Patentable Subject Matter

The Office Action rejects claims 1-12, 14-20, 22-24, 37-54, 57-67 and 73-79 under 35 U.S.C. §101 asserting that the claimed invention is directed to non-statutory subject matter. Further, the Office Action rejects claims 1-12, 14-20, 22-24, 37-54, 57-67 and 73-79 under 35 U.S.C. §101 asserting that the claimed invention lacks utility.

Specifically, with respect to non-statutory subject matter, the Office Action asserts that a security policy is neither a process, machine, manufacture nor composition of matter, but is a common idea or concept shared among members of an organization. Further, with respect to lack of utility, the Office Action asserts that the claims result in a security policy and that, based upon references cited from "Computer Security Reference Book," Jackson et al., 1992, a security policy is but an abstract idea. Therefore, the Office Action asserts that claims 1-12, 14-20, 22-24, 37-54, 57-67 and 73-79 are directed to non-statutory subject matter because the claims do not result in a concrete, useful, nor tangible result, but rather a mere abstract idea.

Claims 1-12, 14-20 and 22-83 are canceled. Added claims 84-122 are drawn to the subject matter of now-canceled claims 1-12, 14-20, 22, 24, 37-54, 57-67 and 73-79, the previously elected group of claims that were elected in response to March 9, 2005 Restriction Requirement. Added claims 84-122 clearly recite a statutory method, computer-based process in which input is received, processing is performed and a tangible output is generated.

For example, claim 84 recites method of generating a security policy for a predetermined organization that includes, among other features, receiving a field of business identifier, receiving an indicator of rigorousness, retrieving security rules from a stored knowledge base based on the indicator of rigorousness, generating inquiries regarding the retrieved security rules based upon the field of business identifier and the indicator of rigorousness, transmitting the generated inquiries to at least one user, receiving input from the at least one user in response to the transmitted inquiries, tailoring the retrieved security rules based upon the received input to generate a security policy draft, and outputting the generated security policy draft that includes the tailored security rules. Independent claims 99 and 114 recite similar features.

MPEP §2106 entitled, "Patentable Subject Matter-Computer-Related Inventions," states at page 2100-18, col. 1, lines 3-6, that in order for a computer-related process to be statutory, the claimed process must be limited to a practical application. Further MPEP §2106 states at 2100-18, col. 1, lines 13-17, that "[a] claim is limited to a practical application when the method, as claimed, produces a concrete, tangible and useful result; i.e., the method recites a step or act of producing something that is concrete, tangible and useful. See *AT&T*, 172 F.3d at 1358, 50 USPQ2d at 1452. Likewise, a machine claim is statutory when the machine, as claimed, produces a concrete, tangible and useful result (as in *State Street*, 149 F.3d at 1373, 47 USPQ2d at 1601)."

The subject matter positively recited in each of independent claims 84, 99 and 114 is a practical application that produces a concrete, tangible and useful result. For example, the subject matter recited in claim 84 involves receiving a tangible input in the form of a field of business identifier and an indicator of rigorousness, generating output in the form of inquiries based on the received input, receiving input in response to the inquiries, tailoring a set of security rules based upon the received response to the inquiries and outputting the tailored rules.

One of ordinary skill in the art would appreciate the claimed subject matter is useful for facilitating the preparation of security rules that are consistent with globally governing policy, yet tailored to meet the needs of a specific user community. The claimed embodiments may be used to document specific physical network configurations, and configuration and control parameters related to specific equipment components in a physical network configuration.

Independent claims 99 and 114 include similar features and, therefore, independent claims 99 and 114 also recite a practical application that produces a concrete, tangible and useful result for at least the reasons addressed above with respect to claim 84. Dependent claims 85-98, 100-113 and 115-122 depend from claims 84, 99 and 114, respectively, and include all the features of their respective base claims. Therefore, each dependent claim also recites a practical application that produces a concrete, tangible and useful result.

Accordingly, the prior rejections under 35 U.S.C. §101 are moot in view of the cancellation of claims 1-83 and are not applicable to the subject matter of added claims 84-122.

III. Rejection Under 35 U.S.C. §112, First Paragraph

The Office Action rejects claims 1-12, 14-20, 22-24, 37-54, 57-67 and 73-79 under 35 U.S.C. §112, first paragraph, asserting that the claimed invention is not supported by either

an asserted utility consistent with the art or an established utility. This rejection is respectfully traversed.

For reasons addressed above, Applicants have met the burden set forth in MPEP §2107 Guidelines for Examination of Applications for Compliance with the Utility Requirement and that the rejection for lack of utility under 35 U.S.C. §101 should be withdrawn.

As stated in MPEP §2107.IV, entitled, "Relationship Between 35 U.S.C. §112, First Paragraph, and 35 U.S.C. §101," a rejection under 35 U.S.C. §112, first paragraph, should not be imposed or maintained unless an appropriate basis exists for imposing a rejection under 35 U.S.C. §101. In other words, an Office Action should not impose a 35 U.S.C. §112, first paragraph, rejection grounded on a "lack of utility" basis unless a 35 U.S.C. §101 rejection is proper.

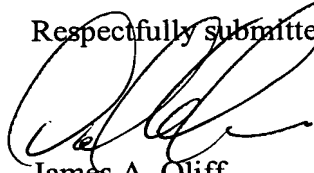
For at least the reasons addressed above, the rejection under 35 U.S.C. §101 for lack of utility should be withdrawn. For at least the same reasons, Applicants assert that the rejection under 35 U.S.C. §112, first paragraph, should also be withdrawn.

IV. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 84-122 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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